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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,639	10/29/2003	Maureen J. Bournier	01040/1 (6794-000126/US)	1858
47376	7590	10/20/2005	EXAMINER	
HARNES, DICKEY & PIERCE, P.L.C.			GODDARD, LAURA B	
7700 BONHOMME			ART UNIT	
SUITE 400			PAPER NUMBER	
ST LOUIS, MO 63105			1642	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,639

Applicant(s)

BOURNER ET AL.

Examiner

Laura B. Goddard, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to an antibody that immunospecifically binds to p-cadherin wherein p-cadherin has the amino acid sequence of SEQ ID NO:39, classified in class 530, subclass 387.1.
- II. Claim 9, drawn to a method of identifying an agent that binds to p-cadherin, classified in class 435, subclass 7.1.
- III. Claim 10, drawn to a method for identifying an agent that modulates the **expression of p-cadherin mRNA**, as contemplated in the specification, classified in class 435, subclass 6.
- IV. Claim 10, drawn to drawn to a method for identifying an agent that modulates the **expression of p-cadherin protein**, as contemplated in the specification, classified in class 435, subclass 7.1.
- V. Claim 10, drawn to a method for identifying an agent that modulates the **activity of p-cadherin protein**, as contemplated in the specification, classified in class 435, subclass 7.1.

- VI. Claim 11, drawn to a method of treating or preventing a cancer-associated disorder, classified in class 514, subclass 2.
- VII. Claims 12, drawn to a method of detecting differentially expressed genes correlated with a cancerous state of a mammalian cell comprising detecting a gene product wherein the gene product is encoded by SEQ ID NO:1, classified in class 435, subclass 6.
- VIII. Claim 13, drawn to a method for monitoring the progression of a cancer in a patient comprising detecting in a patient sample, the expression of nucleic acid molecule SEQ ID NO:1, classified in class 435, subclass 6.
- IX. Claim 14, drawn to a method of assessing the efficacy of a test compound for inhibiting a cancer in a patient comprising comparing expression of SEQ ID NO:1 in patient sample before and after exposure to the test compound, classified in class 424, subclass 9.2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

Art Unit: 1642

different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group I can be used in affinity chromatography or to produce anti-idiotypic antibodies.

The inventions of Groups II-IX are materially distinct methods which differ at least in objectives, method steps and reagents. For example, Group II is drawn to identifying an agent that binds to p-cadherin, Group III is drawn to identifying an agent that modulates the expression of p-cadherin mRNA, Group IV is drawn to identifying an agent that modulates the expression of p-cadherin protein, Group V is drawn to identifying an agent that modulates the activity of p-cadherin protein, Group VI is drawn to treating or preventing a cancer-associated disorder, Group VII is drawn to detecting differentially expressed genes correlated with a cancerous state of a mammalian cell, Group VIII is drawn to monitoring the progression of a cancer patient, and Group IX is drawn to a method of assessing the efficacy of a test compound for inhibiting cancer in a patient. Each of the groups employs chemically distinct reagents to accomplish the different objectives that comprise different methods steps and different populations. Searching all of the groups with the different objectives, method steps, reagents, and populations would invoke a high burden of search.

The product of Group I is not used in the methods of Groups II-V and VII-IX.

Because these inventions are distinct for the reasons given above and the search required for one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

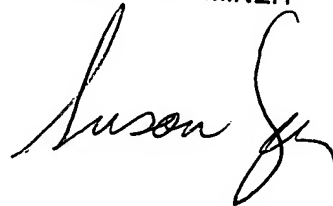
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura B. Goddard, Ph.D. whose telephone number is (571) 272-8788. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura B Goddard, Ph.D.
Examiner
Art Unit 1642

SUSAN UNGAR, PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Susan Ungar", with a stylized flourish at the end.